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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,976	09/10/2003	Alfred Thomas	47079-0227	3979

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EXAMINER

SPRIGG, SEAN M

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/658,976	Applicant(s) THOMAS, ALFRED	
	Examiner Sean Sprigg	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4-5, 8-11, 14-15, 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolf483 (US Pub No 2004/0063483).

Claims 1, 21: Wolf483 discloses a method of conducting a video draw poker game, the game defining a plurality of award-winning rankings and awards associated with the rankings. Wolf483 discloses receiving a wager (par. 32), dealing a plurality of cards into a hand (par. 32), distinguishing winning cards in the hand that yield the winning ranking from other non-winning cards (pars. 33, 39, also see lead line 33), selecting none or more of the cards to be replaced (par. 33), replacing each of the selected cards with a respective replacement card (par. 33), and determining a poker hand ranking for the hand (par. 33). Wolf483 discloses that winning hands result in an award being provided (par. 33). Wolf483 discloses the distinguishing step occurring if the dealt hand includes one of the award winning rankings by disclosing a variety of different auto-hold strategies, including a "conservative" strategy that discloses auto-holding cards which are part of an existing winning combination (par. 44). Additionally, Wolf483 discloses the distinguishing step can only occur if the dealt hand includes a award-winning ranking in that the auto-hold strategies used can be defined by the operator and, therefore allows for the operator to define a auto-

hold strategy that only holds cards that are part of an award-winning ranking hand (pars. 10-11 and 44-62). Wolf483 provides explicit directions for creating the tables and suggests that multiple strategies based on particular preferences have different tables, wherein it is understood that the tables are programmed according to operator preferences. Each table contains entries corresponding to game situation, including situations wherein no winning combinations already exist in the hand. Therefore, any and all strategies for designating hands and types of hands are inherent to Wolf483, and among these strategies is a strategy in which cards are only designated when a winning combination exists. It should also be noted that a designation step does not occur each and every time in Wolf483, as there are situations in which no cards are designated as evidenced by the hold code of 0-0-0-0-0 being displayed should the strategy demand such a hold code to be chosen. Therefore, it is evidenced that a strategy defined by an operator to only designate cards in hands with a winning rank is possible and inherent to Wolf483. In summary, disclosure of a "conservative" strategy serves as evidence that the designation step occurs if there is a winning hand in Wolf483 and is not overcome by mathematical possibilities. Disclosure of a 0-0-0-0-0 hold code serves as evidence that cards need not be distinguished each and every play of the game. And disclosure of game operator's establishing/programming designation strategies as programmed with the techniques disclosed in Wolf483 serves as evidence that any strategy may be defined. Therefore, a strategy defining a designation step that distinguishes

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cards if and only if the dealt hand has an award-winning ranking is disclosed in Wolf483. It should be noted that Wolf483 does not disclose a particular strategy as being the invention or problem to be solved, but rather the methods of using creating and using tables to reduce processing and memory needs as being the purpose of the invention (par. 5).

Claim 11: Wolf483 discloses an apparatus conducting the video draw poker game method having a value input device (lead lines 12, 14), a display (lead line 30), and a processor operative to perform the steps of the game method (lead line 38).

Claim 4, 14: Wolf483 discloses distinguishing winning cards to be held with a label (lead line 33).

Claim 5, 15, 22: Wolf483 discloses the distinguishing step occurring automatically (par. 33).

Claims 8-9, 18-19: Wolf483 discloses the plurality of cards including at least five cards (par. 32) and the cards being dealt from a deck including 52 standard playing cards (par. 32).

Claim 10, 20: Wolf483 discloses the player performing the selecting step with a player input (par. 33).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 12-13, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf'483 in view of Baerlocher'383 (US Pub No 2003/0153383).

Claims 2-3, 12-13, 24-25: Wolf'483 discloses all the features of the presently claimed invention except for the distinguishing step of the game method occurring in response to a player's activation of an "easy hold key", which is merely a button giving the player the option of to activate a game feature of distinguishing certain cards in certain instances.

Baerlocher'383 teaches a game method wherein the player is provided with a button that can be activated by the player (par. 69). If the button is activated a game feature distinguishing certain desirable elements of the game are highlighted (par. 69). Baerlocher'383 teaches this feature to increase the entertainment value of the machine by providing an optional feature that may appeal to a certain players while not forcing all players to use the feature.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Wolf'483 with a button the player can use to activate the distinguishing step of the method for the purposes of increasing the entertainment value of the machine by allowing some players to enjoy a using the distinguishing step feature while not forcing all users to use the distinguishing step.

5. Claims 6-7, 16-17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf'483 in view of Davids'536 (USPN 5,833,536).

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Claims 6-7, 16-17, 23: Wolf'483 discloses all the features of the presently claimed invention except for the distinguishing being highlighting and flashing of winning ones of cards.

Dauids'536 teaches a game that distinguishes certain indicia, such as electronically represented playing cards, by highlighting and flashing them (col. 7 lines 61-67). Dauids'536 teaches this type of distinguishing feature because it is a more effective technique to draw player's attention to a highlighted/flashing object in a display than it is to draw their attention to a dim/static object in a display.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Wolf'483 with a distinguishing step including highlighting and flashing of winning cards as taught in Dauids'536 for the purposes of attracting more attention to distinguished cards than a dim or static display.

Response to Arguments

6. Applicant's arguments filed 7/24/06 have been fully considered but they are not persuasive. Applicant argues that Wolf'483 does not disclose "if and only if the dealt hand has one of the award-winning ranking" a distinguishing step occurs. Applicant also argues that Wolf'483 teaches away from providing a distinguishing step.

Examiner respectfully disagrees. Applicant is referred to the above explanation provided on Wolf'483 and what it discloses. In short, Applicant has misinterpreted the intention of Wolf'483 and what it discloses both explicitly and implicitly. Namely, Wolf'483 discloses a method and system for programming auto-hold strategies in a

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gaming device and makes it apparent that a number of gaming strategies can be programmed through the method and system. Through further evidence it is apparent that the method and system of Wolf483 include a strategy wherein only hands with winning combinations or rankings are distinguished. The fact that Wolf483 appears to disclose other strategies in detail does not mean that the strategy claimed in the present application, which includes "if and only if the dealt hand has one of the award-winning rankings, is excluded or taught away from. Applicant is mistaken in construing explicit disclosure as teaching away that which is implicit to the reference. Thus it is clear that Applicant's claimed invention can be and is taught by Wolf483.

Furthermore, Applicant may argue that Wolf483 contains more structure in allowing multiple strategies to be programmed in determining when to distinguish winning cards in a hand. However, Wolf483 discloses the invention as claimed. The fact that it discloses additional structure not claimed, such as programming other strategies, is irrelevant.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Sprigg whose telephone number is (571) 272-5562. The examiner can normally be reached on Monday - Friday, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMS
12/30/06


SCOTT JONES
PRIMARY EXAMINER